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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/992,095   | 11/13/2001  | Stephane Bejanin     | 91.US5.DIV          | 1774             |
| 23557  | 7590        | 06/15/2004           | EXAMINER            |                  |
| SALIWANCHIK LLOYD & SALIWANCHIK<br>A PROFESSIONAL ASSOCIATION<br>2421 N.W. 41ST STREET<br>SUITE A-1<br>GAINESVILLE, FL 326066669 |             |                      | SAKELARIS, SALLY A  |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1634                |                  |

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/992,095

Applicant(s)

BEJANIN ET AL.

Examiner

Sally A Sakelaris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-13 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***RESTRICTION***

1. Restriction to one of the following inventions is required under 35 U.S.C. §121:

I. Claim 1 is drawn to polynucleotide sequences, vectors, host cells, methods for expression of nucleic acids and with a physiologically acceptable carrier, classified in Class 435, subclasses 69.1, 252.3, and 320.1, Class 536, subclass 23.5, 24.31 and 24.33. Class 514, subclass 44.

II. Claim 2 is drawn to polypeptides as classified in Class 530, subclass 350.

III. Claims 3 and 4 are drawn to a method of making polypeptides, classified in Class 435, subclass 69.1 and Class 435 subclass 70.1, and Class 530 subclass 412.

IV. Claims 5 is drawn to an antibody as classified in Class 530, subclass 387.

V. Claim 6 is drawn to a method of binding a polypeptide to an antibody, classified in Class 435, subclass 7.1.

VI. Claims 7-10 are drawn to a method of detecting expression using nucleic acids classified in Class 435 subclass 6, polypeptides Class 435 subclass 7.1, or antibodies Class 435 subclass 7.1(One biomolecule must be elected, see below).

VII. Claims 11-13 are drawn to a method of identifying a candidate modulator of a Plasminute polypeptide and making a physiologically acceptable carrier classified in Class 435, subclass 7.1 and Class 435, subclass 4.

2. The inventions are distinct, each from the other because of the following reasons:

a. Inventions I and II are patentably distinct in structure and physiochemical properties. Invention I is drawn to nucleic acids whereas invention II is drawn to proteins. Because nucleic acids are composed of nucleotides and proteins are composed

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of amino acids, the inventions have different structural and functional properties.

Furthermore, the compositions are utilized in different methodologies, such that nucleic acids may be utilized in hybridization assays, while the proteins may be utilized in ligand binding assays or to generate antibodies. The protein of invention II does not require the particular products of the nucleic acids of group I since the proteins of invention II can be isolated from natural sources or chemically synthesized.

b. Inventions I and IV are patentably distinct in structure and physiochemical properties. Invention I is drawn to nucleic acids whereas invention IV is drawn to antibodies. Because nucleic acids are composed of nucleotides and antibodies are composed of amino acids, the inventions have different structural and functional properties. Furthermore, the compositions are utilized in different methodologies, such that nucleic acids may be utilized in hybridization assays, while the antibodies may be utilized in assays to detect the presence or absence of a protein. The nucleic acids of invention I are not required to obtain the antibodies of invention IV.

c. Inventions I and III and I and VI(provided that nucleic acids are elected) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the nucleic acids of invention I can be used in a materially different process such as for sequencing reagents and involving amplification and sequencing methods in order to achieve the objective of genotyping an individual for pedigree analysis.

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d. Inventions I and V, I and VI (provided that either polypeptides or antibodies are elected) and I and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions and are not disclosed as capable of use together because the nucleic acids of invention I are not required to practice the methods of inventions V, VI, and VII involving polypeptides or antibodies.

e. Inventions II and IV are patentably distinct in structure and physiochemical properties. Invention II is drawn to polypeptides whereas invention IV is drawn to antibodies. The polypeptide of Group II is composed of amino acids linked in peptide bonds and arranged spatially in a number of different tertiary structures including alpha helices, beta-pleated sheets, and hydrophobic loops (transmembrane domain). The antibody of Group IV is also composed of amino acids linked in peptide bonds and arranged spatially in a very specific tertiary structure that allows that antibody to specifically bind to particular regions, i.e. epitopes, of the encoded polypeptide. Further, antibodies are glycosylated and their tertiary structure is unique, where four subunits (2 light chains and 2 heavy chains) associated via disulfide bonds into a Y-shaped symmetric dimer. The products of inventions II and IV are utilized in materially different processes such that the proteins of invention II may be used to make a fusion protein while the antibodies of invention IV may be used in an immunoassay. Consequently, the reagents, reaction conditions, and reaction parameters required to make or use each invention are different. Therefore, the inventions of Groups II, and IV are patentably distinct from each other.

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f. Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the polypeptides can be made synthetically.

g. Inventions II and V, II and VI(providing that a polypeptide is elected), and II and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptides of invention II can be used in a materially different process such as in creating a fusion protein construct.

h. Inventions III and V, III and VI, and III and VII are patentably distinct methods because they each have different objectives, different uses, different reagents and different method steps. Group III is drawn to a method drawn to a method of making polypeptides, Group V is drawn to a method of binding a polypeptide to an antibody, Group VI is drawn to a method of detecting expression using either nucleic acids, proteins or antibodies and Group VII is drawn to a method of identifying a candidate modulator of a Plasminute polypeptide and making a physiologically acceptable carrier. The methods all have different method steps, objectives and reagents. Therefore the methods are distinct over one another.

i. Invention IV and V and IV and VI(provided that the antibody is elected) are related as product and process of use. The inventions can be shown to be distinct if either

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or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibodies of invention IV can be used in a materially different process such as for the detection of unknown proteins in a Western Blot detection step.

j. Invention IV and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions and are not disclosed as capable of use together because the antibodies of invention IV are not required to practice the methods of inventions IV and VII involving polypeptides or polynucleotides.

**Sequence Election Requirement Applicable to All Groups:**

3. Each sequence is patentably distinct because they are unrelated sequences, i.e. these sequences are unrelated because the protein encoded by these sequences differs in structure and in function and in biological activity. A restriction is applied to each Group. For an elected Group drawn to a nucleotide sequence, the Applicants must elect a single nucleic acid sequence from SEQ ID NO: 53 or SEQ ID NO:54. The same is true for the election of a group drawn to polypeptides or antibodies, only a single polypeptide or antibody respectively may be prosecuted.(See MPEP 803.04). Likewise, if applicant elects Group VI, a single biomolecule(DNA, protein, or antibody) and its single corresponding SEQ ID NO: to prosecute as each have a patentably distinct structure and physiochemical properties.

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**Applicant is advised that examination will be restricted to only the elected SEQ ID**

**NO: and should not to be construed as a species election.**

The search of the selected sequence may include the complements of the selected sequences and, where appropriate, may include subsequences within the selected sequences (e.g., oligomeric probes and/or primers).

Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. Similarly, proteins comprising unique amino acid sequences are structurally and functionally distinct. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequences are presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by the different classifications and their divergent subject matter and because these inventions require different searches that are not co-extensive, examination of these distinct inventions would pose a serious burden on the examiner and therefore restriction for examination purposes as indicated is proper.

5. Applicant is advised that the reply to this requirement, to be complete, must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection



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are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sally A Sakelaris whose telephone number is 571-272-0748. The examiner can normally be reached on M-Fri, 9-6:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Sally Sakelaris

  
6/10/04

  
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